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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,488	06/09/2000	Dean F. Jerding	A-6600	2510

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SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 12/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/590,488

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. As previously noted in Paper No. 12, claims 33-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

### *Priority*

2. With respect to the applicant's request for receiving benefit to an earlier filing date under 35 U.S.C. 119(e), upon further consultation it was decided that the provisional application in its entirety must be considered with respect to the claim for priority and as such the previous Notice of Non-Responsive Amendment, Paper No. 12 was premature.
3. Upon further consideration and in view of the newly presented claims, it is the examiner's opinion that adequate support under 35 U.S.C. 112 for claims 38-55 is found in conjunction with the "Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal" by Shashi Goel. With respect to claims 56-65, while the aforementioned document does not explicitly disclose that the "Explorer 2000™ Digital Home Communications Terminal" comprises a "memory" and "program code stored in said memory", it is the examiner's opinion that such limitations are inherent to the operation of a graphical "client" interface in conjunction with a set top box such as the Explorer 2000™ DHCT and as such one skilled in the art can reasonably

conclude that the inventor had possession of the claimed invention wherein a DHCT such as the Explorer 2000™ inherently comprises “memory” and “program code stored in said memory”. Further evidence with respect to the DHCT comprising “memory” and “program code stored in said memory” is found in conjunction with the “System Architecture Specification for Video-On Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal” by Tim Addington (Page 24). Accordingly, claims 38-65 receive the benefit of the earlier filing date of 11 June 1999 under 35 U.S.C. 119(e) in light of the Goel document.

#### *Drawings*

4. The drawings were received on 14 October 2003. These drawings are approved with respect to enclosed Figures 4C, 4D, 4H, 4I, and 7.
5. The drawings are objected to because Figure 19A contains two references to element “270”. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference sign “216” mentioned in the description (Page 16, Line 30). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Response to Arguments*

7. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the applicant's cancellation of all previously presented claims and presentation of new claims 38-65. No evidence pertaining to the challenge of the OFFICIAL NOTICE is being provided as the limitations for which the notice was taken is moot as these limitations are not present in the currently pending claims. Accordingly, a new ground(s) of rejection is presented as follows.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(f) he did not himself invent the subject matter sought to be patented.

9. Claims 38-65 are rejected under 35 U.S.C. 102(a) as being anticipated by Goel (Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal) hereafter referred to as the Goel reference.

Claims 38-50 are rejected wherein the claimed method is illustrated in conjunction with the UI Flow Diagrams and corresponding discussion pertaining to the implementation VOD Client interface. In particular, the claimed limitation pertaining to “providing a list of selectable VOD titles responsive to determining that the active VOD session does not exist” as noted by the applicant as a patentable

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feature over the art of record is clearly illustrated in the VOD UI Flow Diagram (Page 11).

With respect to claims 51-55, the limitations pertaining to “responsive to receiving the second user input identifying the first access code, prompting the user to provide a third user input identifying a second access code” is clearly illustrated in conjunction with the VOD UI Flow Diagram (Page 11) wherein a user may be required to enter both an unblock and a purchase PIN in conjunction with ordering a video.

Claims 56-60 are rejected as aforementioned in the grounds of rejection of claims 38-50 wherein the method may be implemented via a DHCT such as the Explorer 2000™ which inherently comprises a “memory” and “program code stored in said memory”.

Claims 61-65 are rejected as set forth in the grounds of rejection of claims 51-55 wherein the method may be implemented via a DHCT such as the Explorer 2000™ which inherently comprises a “memory” and “program code stored in said memory”.

10. Claims 38-65 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. As evidenced by the Goel reference, the inventive entity comprising Dean Jerding, Robert Banker, Arturo Rodriquez, Valerie Gutknecht, and Shashi Goel does not appear to be the inventor of the claimed subject matter. Rather, the claimed subject matter as clearly illustrated in the Goel reference appears to be solely invented by Shashi Goel. No reference to Arturo Rodriguez, Robert Banker, and/or Vlaerie Gutknecht as inventors appears to be made in either the provisional application or the Goel reference.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The "System Architecture Specification for Video-On-Demand Application Development on the Explorer 2000(tm) Digital Home Communications Terminal" reference by Timothy H. Addington discloses the general system architecture required to support a VOD application running on the Explorer digital HCT network. It is noted that the presence or absence of a confidentiality agreement is not itself determinative of public disclosure. See MPEP § 21.3303(a).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

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period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB  
December 12, 2003

  
JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600